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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,183	07/15/2003	Hirobumi Toyoda	3022-14	4966

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EXAMINER	
SHAH, MILAP	

ART UNIT	PAPER NUMBER
3714	

DATE MAILED: 10/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/619,183	TOYODA, HIROBUMI	
	Examiner	Art Unit	
	Milap Shah	3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 July 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *15 July 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *12/16/03, 1/19/05, 5/25/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

Applicant is advised that should claim 2 be found allowable, claim 4 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the last limitation of claim 3, the phrase "and/or" is used, which produces an indefiniteness to the claim language. It is unclear if both are required or either are required. Furthermore, it is unclear if (A) causing said display part to show an image of the real player being taken at a predetermined timing by said image taking means or (B) causing the response image data being stored by said response image data storage means according to the state of the game being played with the gaming machine are related events and should be under a single limitation. (A) discloses displaying of an image, while B discloses the saving of a different image. Due to the indefiniteness, thee Examiner is interpreting the "and/or" phrase to be an "or" and also since it is interpreted as an "or", part A has already been recited in an earlier limitation of claim 3, thus, the instant limitation is entirely equivalent and rejected with the earlier limitation of claim 3.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 10 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 10 claims a computer program per se, which is considered to be non-statutory subject matter. A "computer program" falls under "abstract ideas". According to MPEP 2106, computer programs "are neither computer components nor statutory processes, as they are not 'acts' being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and the other claimed elements of a computer which permit the computer program's functional to be realized". The Examiner suggests changing claim 10's preamble from "A program being executed with a gaming machine... " to "A computer program recorded on a computer readable medium for execution by a gaming machine... " so that the computer program is recorded on a tangible object, which is executable by a gaming machine.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4-6, & 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Miyamoto et al. (U.S. Patent No. 6,607,443).

Claim 1: Miyamoto et al. disclose the same invention including a display part for displaying the state of the game (figure 1[display 7]) and a control part (i.e. CPU or controller of the gaming machine) for controlling the state of the game in accordance with information input by a plurality of players (see at least abstract, column 4, line 66 – column 5, line 4, and "summary of invention"). The plurality of players consist of at least one real player on the player side competing against at least one virtual player on the dealer side, such as when playing the game of blackjack (column 1, lines 15-57). Miyamoto also discloses the storage of "response images" corresponding to the response actions the dealer would make in response to the input from the sensors regarding the actions required by the game and player, such as when the player requires an additional card to be dealt in blackjack (i.e. a "hit"), these instructions are interpreted by the CPU and processed to display the virtual dealer dealing an additional card. An additional example of expression or response imaging by the virtual player is seen in the response to a blackjack being achieved; the response images show excitement (see at least abstract; column 9, line 8 – column 10, line 8; and figures 6A-7). These response images process according to the state of the game, as discussed above, when a player needs an additional card, the response images is considered to be the image of the dealer in a dealing motion.

Claims 2 & 4: The "predetermined timing" includes timing at which a change is about to occur, thus, when the player's hand movements indicate to the CPU that the player wants an additional card, this is a change that is about to occur, thus, response images for the particular action will be displayed (column 9, lines 14-37).

Claims 5, 6, & 8: Miyamoto et al. disclose a first virtual player and a second virtual player have different response images to the same action or "change of the state of the game", when the sound level of the players is different. The first virtual player and the second virtual player may have the same graphical representation with different emotions or gestures, however, these can be considered "twins" with different emotions or gestures when the same event occurs. For example, Miyamoto et al. disclose that when a blackjack is achieved and the noise level is at a "level 1" the response image may look like figure 6D, however, when the noise level is at a "level 2" the response image may look like figure 6E. Thus, the virtual players used at each of the three sound levels are considered different virtual players (see at least column 7, line 15 – column 8, line 40 & figures 6A-7).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3, 7, 9, & 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto et al., as applied to claim 1 above.

Claim 3: It is noted that claim 3 includes many of the limitations of claim 1, see the above rejection of claim 1for details on these specific limitations. In addition to those limitation, Miyamoto et al. disclose an image taking means for taking an image of the real player (figure 1[CCD cameras 14]) and storing the image as "image data" in a storage means, for use in the

image recognition circuit 16 (figure 4). Miyamoto et al. also disclose a detection means for detecting player insufficiency in playing the game (i.e. sound levels 1-3 are used to indicate the level of excitement or noise of the players playing the game) and based on the detection, selecting the virtual player to be used in the game (column 7, lines 15-34 discloses determining the sound level; figures 6B-7 & column 7, line 43 – column 8, line 40 discloses how the response data or images are used corresponding to the determined sound level).

Miyamoto et al. lack displaying the "image data" of the real player, however, the image data is saved for use in the image recognition circuit, thus, it would have been an obvious matter of design choice to the designer of the gaming machine to output that image data to the display or not to output the image data to the display, considering the image data is available for output if desired. Therefore, it would have been an obvious matter of design choice to one of ordinary skill at the time of the invention, since the Applicant has not disclosed that displaying the "image data" of the real player solves any stated problem or is for any particular purposes other then aesthetics. Therefore, it would have been prima facie obvious to modify Miyamoto et al. to obtain the invention as specified in claim 3.

Regarding claim 9, the server is considered the overall connection between all of the satellite player stations (i.e. gaming machines), which are all connected to the server via communication lines (figure 4). The "gaming machine" components are discussed above.

Regarding claim 10, the overall processes of the server and gaming machines are controlled via a computer program stored on a computer readable medium, the program causing the above components to operate (column 2, lines 11-18).

Claim 7: Miyamoto et al. disclose a first virtual player and a second virtual player have different response images to the same action or "change of the state of the game", when the

sound level of the players is different. The first virtual player and the second virtual player may have the same graphical representation with different emotions or gestures, however, these can be considered "twins" with different emotions or gestures when the same event occurs. For example, Miyamoto et al. disclose that when a blackjack is achieved and the noise level is at a "level 1" the response image may look like figure 6D, however, when the noise level is at a "level 2" the response image may look like figure 6E. Thus, the virtual players used at each of the three sound levels are considered different virtual players (see at least column 7, line 15 – column 8, line 40 & figures 6A-7).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Name	Reference	Applicability
Oh	U.S. Patent No. 5,616,078	The generation of response images, responding to player input in the form of movement.
Kennedy	U.S. Patent No. 5,688,174	Multiplayer interactive video gaming device.
Yang	U.S. Patent Application Publication No. 2003/0119574	A computer-implemented method and gaming apparatus for allowing a player-banker to play against at least one virtual opponent.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milap Shah whose telephone number is (571) 272-1723. The examiner can normally be reached on M-F: 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hotaling can be reached on (571) 272-4437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M.B.S.

Scott Jones

SCOTT JONES
PRIMARY EXAMINER